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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,241	06/16/2000	Yukio Yamakawa	3620-4006	2778
7590 10/08/2003			EXAMINER	
Morgan & Finnegan LLP 345 Park Avenue New York, NY 10154-0053			SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 10/08/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,241

Applicant(s)

YAMAKAWA ET AL.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. Applicant's request for continuing examination has been carefully considered and entered. Claim 1 has been amended, claims 2-9 have been canceled, and new claim 10 has been added. Applicant's amendment and accompanying remarks are found sufficient to overcome the rejection to claim 1 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Applicant's own Admission as previously set forth in the Final Office Action. As such, this claim is now patently distinct and is therefore in condition for allowance for reasons set forth herein below. However, with regard to newly added claim 10, the claimed subject matter in conjunction with Applicant's accompanying remarks are not found to patentably distinguish this claim over the prior art of record for reasons set forth herein below.

Claim Rejections - 35 USC § 102/103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 10 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Applicant's own Admission.

In the present specification, prior art figure 9 is described as having a pair of nip rollers (120) that take up the non-woven fabric from the conveyor (115) (Page 5, lines 14-20). Applicant teaches that the nip rollers (120) are pressed against each other, are disposed to be in parallel to each other in the vertical direction, and function to pull the non-woven fabric carried on the conveyor off the conveyor (Page 6, 10-20). In addition,

Art Unit: 1771

Applicant teaches that nip rollers (120) peel the non-woven fabric from the belt conveyor (Page 7, 15-20).

Since Applicant's own admission reads on the present product by process claim limitations, it is asserted that the claimed tension to unroll the non-woven roll must be inherent to the admitted prior art process and product. Support for said presumption is found in the use of like materials (i.e., thermoplastic elastomer fibers used to create a coherent web) and the use of like processes (i.e., peeling the sheet of non-woven fabric thus formed from said conveyor with a roller), which would result in the claimed property. The burden of proof is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed property of the required tension to unroll the non-woven roll would obviously have been present once the prior art product is provided. *In re Best*, 195 USPQ at 433

If said property is not inherent, it is then asserted that Applicant's claim must be incomplete. In other words, if Applicant asserts a lack of inherency in the admitted prior art process, then Applicant's claimed invention is missing an element critical to the invention, which would patentably distinguish the instant invention from that of the admitted prior art invention.

4. Claim 1 is rejected under 35 U.S.C. 102 (b) anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al., US 5,814,569.

The patent issued to Suzuki et al. discloses a non-woven elastic fabric (Abstract). The reference discloses a prior art method used to form elastic non-wovens having elasticity in the cross direction that includes orienting staple fibers by combing and piling

Art Unit: 1771

according to a carding method (Column 1, lines 56-67, and Column 2, line 1). The elastic non-woven comprises conjugate filaments of a polyester polymer and a polyolefin polymer having a sheath-core arrangement (Column 4, lines 34-36). Suitable polyolefin polymers include various low, medium, and high polyethylene and polypropylene. The manufacturing process includes the steps of accumulating said conjugate filaments on a conveyor to form a web, partially heating to form a filamentous fleece having heat-bonded areas and applying a heat drawing to said filamentous fleece (Column 4, lines 18-29). Step 4 in the flow diagram of figure 1 teaches winding up the elastic non-woven to form a roll. Suzuki et al. further teaches that each of the steps in the flow diagram of figure 1 is carried out continuously on a production line (Column 11, lines 44-54).

Although, Suzuki et al., fails to teach the claimed tension to unroll the non-woven roll it reasonable to presume that said required unroll tension is inherent to the invention of Suzuki et al. Support for said presumption is found in the use of like materials (i.e., elastomer fibers used to create a coherent non-woven web) and the use of like processes (i.e., winding said formed non-woven web to form a roll), which would result in the claimed property. The burden of proof is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed property of the required tension to unroll the non-woven roll would obviously have been present once the prior art product of Suzuki et al., is provided. *In re Best*, 195 USPQ at 433

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter: Claim 1.

Art Unit: 1771

While there is nothing particularly novel regarding the elastomeric non-woven roll of the instant claims, presently, no prior exists that teaches or suggests a non-woven roll of fabric wherein the tension required to unroll the non-woven fabric from the roll is .25g/cm/basis-weight or less. The method steps recited in claim 1 impart an internal tension to the non-woven roll that is much less than that found in the prior art of record. The resulting lower internal tension creates a less tightly wound² roll which gives rise to the claimed tension requirement.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

September 28, 2003

ls

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700